

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 11

REMARKS

Claims 1-12, 14-24 and 37-57 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Applicants would like to thank the Examiner for taking the time for a telephone interview on September 9, 2003, in which claims 1 and 2 in regard to the Varlonga 4,130,972 patent and claim 1 in regard to the Omholt et al. 4,423,573 patent were discussed. The contents of the interview regarding these claims are included in the arguments below. Furthermore, the Examiner indicated that the present Office Action is non-final.

In the Office Action, the Examiner has indicated claims 4, 7-10, 15, 16 and 19-22 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants would like to thank the Examiner for that notification.

Claims 1-3 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,130,972 to Varlonga. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicant respectfully asserts that the Examiner has not yet met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

Claim 1 defines a partition for open building space including, among other things, a frame including at least one substantially horizontal surface, a cover member being configured to enclose at least a portion of said frame, the cover member including attachment members configured to connect the cover member to the frame, and a seal attached to the cover member, and including a resilient flap which engages the substantially horizontal surface of the frame to inhibit the passage of acoustical energy through the partition.

The Varlonga '972 patent does not disclose or suggest all of the above noted features of claim 1. Specifically, the Varlonga '972 patent does not disclose a seal attached to a cover

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 12

member and including a resilient flap which engages a substantially horizontal surface of a frame. As illustrated in Fig. 1 of the Varlonga '972 patent, the gasket 18 is located between a side edge 6a of a plate 6 and a vertical face of the stringer 3. However, the gasket 18 is not attached to the plate 6. In the interview, the Examiner indicated that the gasket 18 is attached to the plate 6 because the gasket 18 is touching the plate 6 and is stationary when the wall 1 is fully assembled. However, the gasket 18 is not attached to the plate 6 because an element separate from the plate 6, namely the stringer 3, is required to maintain the gasket 18 in contact with the plate 6. Accordingly, the gasket 18 is not attached to the plate 6. Furthermore, as illustrated in Fig. 1 of the Varlonga '972 patent, the gasket 18 only engages a vertical face, and not a horizontal surface, of the stringer 3. Accordingly, claim 1 is not anticipated by the Varlonga '972 patent.

Claims 2, 3 and 11 depend from claim 1, and since claim 1 is not anticipated by the Varlonga '972 patent, claims 2, 3 and 11 are not anticipated by the Varlonga '972 patent. Furthermore, in regard to claim 2, the Varlonga '972 patent does not disclose a seal having a U-shaped groove configured to accept a substantially horizontal flange of a cover member to frictionally connect the seal to the cover member. First, as disclosed in Fig. 1 of the Varlonga '972 patent, the gasket 18 does not have a U-shaped groove having any portion of the plate 6 accepted therein. Furthermore, since the gasket 18 is only in contact with the plate 6 because of the stringer 3, the gasket 18 does not accept a substantially horizontal flange of the plate 6 to frictionally connect the gasket 18 to the plate 6. Moreover, in regard to claim 3, the gasket 18 does not include at least one finger extending into a U-shaped groove that frictionally engages a horizontal flange of the plate 6. Accordingly, claims 2, 3 and 11 are not anticipated by the Varlonga '972 patent.

Claims 1, 14 and 37-42 have been rejected under 35 U.S.C. §102(b) as being anticipated by the Omholt et al. 4,423,573 patent. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 13

anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicant respectfully asserts that the Examiner has not yet met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

The Omholt et al. '573 patent does not disclose or suggest all of the above noted features of claim 1. Specifically, the Omholt et al. '573 patent does not disclose a seal including a resilient flap which engages a substantially horizontal surface of a frame. In the interview, the Examiner clarified her interpretation of the relationship of the cover member and the seal in the Omholt et al. '573 patent. However, as illustrated in Figs. 9 and 10 of the Omholt et al. '573 patent, the clips 22 only abut vertical edges, and therefore not a horizontal surface, of apertures 13 in the frame 10. Furthermore, the clip 22 does not connect the insert 11 to the frame 10. The clip support 21 connects the clip 22 to the frame 10. Therefore, the Omholt et al. '573 patent does not disclose attachment members configured to connect a cover member to a frame. Accordingly, claim 1 is not anticipated by the Omholt et al. 4,423,573 patent.

Claims 37-39 and 42 depend from claim 1, and since the Omholt et al. '573 patent does not anticipate claim 1, the Omholt et al. '573 patent does not anticipate claims 37-39 and 42. Furthermore, in regard to claim 42, claim 42 depends from claim 5. Since the Omholt et al. '573 patent does not anticipate claim 5, the Omholt et al. '573 patent does not anticipate claim 42. Accordingly, the Omholt et al. 4,423,573 patent does not anticipate claims 1, 37-39 or 42.

Claim 14 defines a cover panel for a partition having a frame with a horizontal surface including, among other things, a cover member being configured to enclose at least a portion of the frame, said cover member including attachment members configured to connect said cover member to the frame, and a seal attached to said cover member, and including a resilient flap configured to engage the horizontal surface of the frame when said cover member is connected to the frame to inhibit the passage of acoustical energy through said partition.

The Omholt et al. '573 patent does not disclose or suggest all of the above noted features of claim 14. Specifically, the Omholt et al. '573 patent does not disclose a seal including a resilient flap which is configured to engage a substantially horizontal surface of a

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 14

frame. As illustrated in Figs. 9 and 10 of the Omholt et al. '573 patent, the clips 22 only abut vertical edges, and therefore not a horizontal surface, of apertures 13 in the frame 10. Furthermore, the clip 22 does not connect the insert 11 to the frame 10. The clip support 21 connects the clip 22 to the frame 10. Therefore, the Omholt et al. '573 patent does not disclose attachment members configured to connect a cover member to a frame. Accordingly, claim 14 is not anticipated by the Omholt et al. 4,423,573 patent. Moreover, claims 40 and 41 depend from claim 14, and since the Omholt et al. '573 patent does not anticipate claim 14, the Omholt et al. '573 patent does not anticipate claims 40 or 41. Accordingly, the Omholt et al. '573 patent does not anticipate claims 14, 40 or 41.

Claim 24 has been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,087,944 to Mecklenburg in view of U.S. Patent No. 4,028,855 to Prewer. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made,' because the references relied upon teach all aspects of the claimed invention were individually known in the prior art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 15

combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); M.P.E.P. §2142. Applicants respectfully assert that the Examiner has not yet met the Examiner's burden of establishing a *prima facie* case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate, and should be withdrawn.

The prior art of record does not disclose or suggest the above noted features of claim 24. Specifically, in regard to the third criteria of obviousness, the prior art of record does not disclose or suggest all of the claim limitations of claim 24. Specifically, neither the Mecklenburg '944 patent nor the Prewer '855 patent disclose a seal attached to a cover member and including a resilient flap which engages a substantially horizontal surface of a frame. As illustrated in Fig. 4 of the Mecklenburg '944 patent, the ceiling strip 11 is located between a panel element 5 and a ceiling 16. However, the ceiling strip 11 is not attached to the panel element 5. The ceiling strip 11 is not attached to the panel element 5 because an element separate from the panel element 5, namely the ceiling 16, is required to maintain the ceiling strip 11 in contact with the panel element 5. Accordingly, the ceiling strip 11 is not attached to the panel element 5. Therefore, claim 24 is in condition for allowance.

Claims 1, 5, 6, 14, 17, 18 and 23 have been rejected under 35 U.S.C. §103 as being unpatentable over U.S Patent No. 6,023,899 to Mecozzi. Furthermore, claim 12 has been rejected under 35 U.S.C. §103 as being unpatentable over the Mecozzi '899 patent in view of the Prewer '855 patent. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 16

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made,' because the references relied upon teach all aspects of the claimed invention were individually known in the prior art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992); M.P.E.P. §2142. Applicants respectfully assert that the Examiner has not yet met the Examiner's burden of establishing a *prima facie* case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate, and should be withdrawn.

The Mecozzi '899 patent does not disclose or suggest all of the above-noted features of claim 1. Specifically, the Mecozzi '899 patent does not disclose a resilient flap which engages a substantially horizontal surface of a frame. While a portion of the liner bracket 92 may extend horizontally, that does not mean that the liner bracket 92 has a horizontal surface. As disclosed in the Mecozzi '899 patent, the liner bracket 92 only has a vertical surface touching the seal 96. Furthermore, the Mecozzi '899 patent does not disclose a seal attached to a cover member and including a resilient flap which engages a substantially horizontal surface of a frame. As illustrated in Fig. 1 of the Mecozzi '899 patent, the seal strip 96 is located between the liner bracket 92 and a leg portion 34. However, the seal strip 96 is not attached to the liner bracket 92. The seal strip 96 is not attached to the liner bracket 92 because an element separate from the liner bracket 92, namely the leg portion 34, is required to maintain the liner

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 17

bracket 92 in contact with the liner bracket 92. Accordingly, the seal strip 96 is not attached to the liner bracket 92. Therefore, claim 1 is not unpatentable over the Mecozzi '899 patent. Furthermore, claims 5, 12 depend from claim 1, and since claim 1 defines unobvious patentable subject matter, claims 5, 6 and 12 define patentable subject matter. Accordingly, claims 1, 5, 6 and 12 define patentable subject matter.

The Mecozzi '899 patent does not disclose or suggest all of the above-noted features of claim 14. Specifically, the Mecozzi '899 patent does not disclose a resilient flap which engages a substantially horizontal surface of a frame. While a portion of the liner bracket 92 may extend horizontally, that does not mean that the liner bracket 92 has a horizontal surface. As disclosed in the Mecozzi '899 patent, the liner bracket 92 only has a vertical surface touching the seal 96. Furthermore, the Mecozzi '899 patent does not disclose a seal attached to a cover member and including a resilient flap which engages a substantially horizontal surface of a frame. As illustrated in Fig. 1 of the Mecozzi '899 patent, the seal strip 96 is located between the liner bracket 92 and a leg portion 34. However, the seal strip 96 is not attached to the liner bracket 92. The seal strip 96 is not attached to the liner bracket 92 because an element separate from the liner bracket 92, namely the leg portion 34, is required to maintain the liner bracket 92 in contact with the liner bracket 92. Accordingly, the seal strip 96 is not attached to the liner bracket 92. Therefore, claim 14 is not unpatentable over the Mecozzi '899 patent. Furthermore, claims 17, 18 and 23 depend from claim 14, and since claim 14 defines unobvious patentable subject matter, claims 17, 18 and 23 define patentable subject matter. Accordingly, claims 14, 17, 18 and 23 define patentable subject matter.

New claims 43-57 define the features of the present invention not suggested or disclosed by the cited prior art. Accordingly, claims 43-57 are in condition for allowance.

All pending claims 1-12, 14-24 and 37-57 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Applicant : Donald P. Gravel et al.
Appln. No. : 09/827,642
Page : 18

OFFICIAL

Respectfully submitted,

DONALD P. GRAVEL ET AL.

By: Price, Heneveld, Cooper,
DeWitt & Litton

9/15/03
Date

Marcus P. Dolce
Marcus P. Dolce
Registration No. 46 073
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

MPD/msj

**RECEIVED
CENTRAL FAX CENTER**

SEP 16 2003